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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/888,462	07/07/1997	CURTIS R. SCHARF	2730-01	2198

7590 03/28/2003
PATENT ADMINISTRATOR
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EXAMINER

MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
1764	

DATE MAILED: 03/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/888,462

Applicant(s)

SCHARF ET AL.

Examiner

Ellen M McAvoy

Art Unit

1764

AS-42

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 29 January 2003.

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1,4,6,8-11,13,15-17,19-21,31 and 32 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1,4,6,8-11,13,15-17,19-21,31 and 32 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) ☐ Interview Summary (PTO-413) Paper No(s). _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submissions filed on 23 December 2002 and 29 January 2003 have been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 6, 8-11, 13, 15-17, 19-21 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tipton et al (4,594,378).

As set forth in previous office actions, Tipton et al ["Tipton"] teach polymeric compositions which exhibit improved shear stability in transmission and hydraulic fluids while maintaining high and low temperature viscosity characteristics. The polymeric compositions comprise a mixture of (A) at least one oil-soluble polymer in an amount of about 0.1 to about 20% by weight, (B-1) at least one nitrogen-containing ester of a carboxy-containing interpolymer and/or (B-2) at least one oil-soluble acrylate polymerization product of at least one acrylate ester.

The polymeric component (A) may comprise homopolymers prepared from C_3 - C_{20} monoolefins such as butene and isobutene. See column 3, lines 4 et seq. This clearly meets the limitation of component (A) of the claims when it comprises at least one polymer selected from polyalkylenes wherein the polyalkylene is derived at least one olefin having from 3 to about 30 carbon atoms (dependent claim 4). Number average molecular weights (Mw) of such polymers range from about 500 to about 100,000, and are preferably in the range of about 750 to about 10,000. See column 2, lines 55-65 and the claims. The examiner maintains the position that independent claims 1 and 13 which limit polymer component (A) to one having a Mw less than 50,000 still fails to distinguish this component over Tipton where a polymer having such a Mw is still encompassed.

The polymeric compositions of the prior art may also comprise component (C), at least one low temperature viscosity-reducing liquid organic diluent such as naphthenic oil, alkylated aromatic oils and synthetic carboxylic acid ester oils. See column 18, line 13 to column 19, line 8. The diluent component of Tipton may be present in the composition in an amount of about 1% to about 35% by weight which encompasses the claimed range of about 10% to about 30% by weight for this component. This clearly encompasses fluidizing agent (B) of the instant claims, which is present in the composition in an amount of "up to 30% by weight" which includes 0 %, when it comprises alkylated aromatic hydrocarbons as recited in independent claim 31. In the entered amendments, applicants limit the fluidizing agent of independent claims 1 and 13 to a poly- α -olefin having a kinematic viscosity from about 2 to 30 cSt at 100°C. However, Tipton teaches that synthetic oils useful as diluent (C) are those having a viscosity at 40°C of

from about 2.0 to 3.8 centistokes, and that suitable synthetic oils are described in more detail below. See column 18, lines 37-46. In column 23, synthetic oils which may be used as a diluent include hydrocarbon oils such as polymerized and interpolymerized olefins, e.g., polybutylenes, polypropylenes, poly(1-hexenes), etc., and mixtures thereof. Thus, the examiner is of the position that this clearly encompasses fluidizing agent (B) of the instant claims when it comprises a poly- α -olefin having a kinetic viscosity from about 2 to about 30 cSt at 100°C. The base oils used in preparing the transmission fluids and the hydraulic fluids of Tipton may comprise either natural oils or synthetic oils. Mineral lubricating oils are set forth as an example of a preferred natural oil. See column 23, lines 36 et. seq. Examples of fluid formulations of the invention are set forth in the table in column 25 wherein formulations D, E, and F use 100 Neutral Mineral Oil as the base oil. This is an example of a suitable mineral oil set forth by applicants in the specification on page 5. Tipton also allows for the addition of conventional lubricant additives to the composition in conventional amounts and include detergents, dispersants, extreme pressure agents, anti-wear agents and oxidation inhibitors. See column 19, lines 24 to column 23, top. This clearly encompasses components (C), (D) and (E) of the instant claims. Applicants' open-ended claim language "comprising" allows for the addition of other additives disclosed in Tipton but not required in the claimed oil composition. The independent claims recite the proviso "wherein the lubricating composition has a shear loss of less than about 15% in the 20 hour Taper Bearing Shear Test" which is not taught by Tipton. However, this is not deemed to be persuasive of patentability because the lubricating compositions of Tipton may also have the same shear loss value. Thus, the examiner maintains the position that the

multigrade lubricating compositions of the instant claims are encompassed by the prior art to Tipton.

The claims have been amended to multigrade gear oil compositions which, applicants' argue, differs from the transmission fluids and hydraulic fluids of Tipton. This is not deemed to be persuasive of patentability because claim language that simply specifies an intended use for the invention generally will not limit the scope of a claim, particularly when only presented in the claim preamble. Indeed, the preamble is generally not accorded any patentable weight where it merely recites the intended use. See MPEP 2111.02, and *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

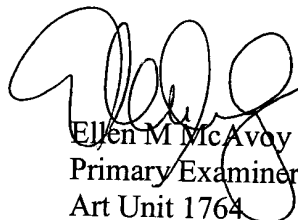
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (703) 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ellen M. McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
March 27, 2003